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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/605,599
Applicant : KAESEMEYER
Filed : June 28, 2000
Group Art Unit : 1614
Examiner : D. C. Jones
Docket No. : 126625.00701
Confirmation No. : 5779

Title: CONTROLLED RELEASE ARGININE FORMULATIONS

PETITION UNDER 37 C.F.R. §1.182 (Questions Not Specifically Provided For)
or
PETITION UNDER 37 C.F.R. §1.183 (Suspension of Rules)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Commissioner:

By this petition, Applicant respectfully requests consideration of the following information, and if necessary, suspension of the rules, regarding an error in the claim of benefit to an earlier filed U.S. application and filing date and cross reference to related applications in connection with the above-referenced abandoned patent application. Specifically, it is requested that the record be amended to correct the immediately prior claimed parent application number to read 09/293,392 (as opposed to 09/239,392). This request is necessary in order to permit a corrected benefit claim in the subsequently filed child U.S. Application No. 10/258,633, filed June 28, 2001.

STATEMENT OF FACTS

The 09/605,599 Application

1. The above-referenced application, U.S. Application No. 09/605,599, was filed on June 28, 2000, which included a Related Application Data statement at page 1, lines 3-12, the pertinent part reading as follows:

“This application is a continuation-in-part application of U.S. Serial No. 09/239,392 filed April 16, 1999 which is a continuation-in-part application of U.S. Serial No. 09/226,580 filed January 7, 1999... ”

A copy U.S. Application No. 09/605,599 is attached hereto for the Examiner's convenience as **Exhibit A**.

2. In the above Related Application Data statement of U.S. Application No. 09/605,599, the application number for the parent continuation-in-part application was incorrectly recited as “U.S. Serial No. 09/239,392” and should have been recited as “U.S. Serial No. 09/293,392.” The correct application number is U.S. Serial No. 09/293,392. A copy of the Official Filing Receipt for U.S. Serial No. 09/293,392 is attached hereto as **Exhibit B**, to evidence the veracity of this fact.

3. The application that was assigned “U.S. Serial No. 09/239,392” is entitled “Vehicle Inflator with Stored Gas for Supplementing Inflation” and was filed on January 28, 1999. It clearly is not related to the subject matter of the above-referenced U.S. Application No. 09/605,599, entitled “Controlled Release Arginine Formulations.” A copy of the USPTO Pair Application Data Record for U.S. Application No. 09/239,392 is attached hereto as **Exhibit C**.

4. The executed Combined Declaration and Power of Attorney document, which was filed in connection with the above-referenced U.S. Application No. 09/605,599 on November 7, 2000,

correctly stated the complete related application data and claim under 35 U.S.C. §120, the pertinent part reading as follows:

“...Serial No. 09/293,392 filed April 16, 1999; Serial No. 09/226,580 filed January 7, 1999....”

A copy of the executed Declaration and Power of Attorney is attached hereto as Exhibit D.

5. The first official Filing Receipt for the above-referenced U.S. Application No. 09/605,599 issued with an incorrect Continuing Data as Claimed by Applicant section, whereby the incorrect Application No. 09/239,392 was indicated. A copy of this first Filing Receipt is attached hereto as Exhibit E.

6. A Preliminary Amendment, which included a request for a corrected Filing Receipt, was filed in the above-referenced U.S. Application No. 09/605,599 on November 7, 2000, to correct the above-noted Related Application Data paragraph error. A copy of this Preliminary Amendment is attached hereto as Exhibit F. Specifically, the requested amendment read:

IN THE SPECIFICATION:

Page 1, line 1, delete “09/239,392” and insert the following -- 09/293,392 --.

A copy of the returned postal card indicating receipt by the OIPE on November 9, 2000, of this Preliminary Amendment and request for corrected Filing Receipt, is attached hereto as Exhibit G.

7. A “Corrected” official Filing Receipt for the above-referenced U.S. Application No. 09/605,599 was mailed March 2, 2001. It did not correct the aforementioned error in the Continuing Data section. The only “corrections” were the addition of the inventor’s address, small entity status and the payment of the filing fee. A copy of this Corrected Filing Receipt is attached hereto as Exhibit H.

8. An Office Action issued on August 15, 2001, in connection with the above-referenced U.S. Application No. 09/605,599 wherein, *inter alia*, a substitute specification was required to be filed "because the top of each page .. is missing sections due to a two-hole punch." A copy of this Office Action is attached hereto as **Exhibit I**.

9. In response to the August 15, 2001 Office Action in the above-referenced U.S. Application No. 09/605,599, a substitute specification that corrected the issues raised in the Office Action was filed on November 15, 2001. The substitute specification did not incorporate the amendment made in the Preliminary Amendment with regard to the Related Application Data, that is, it did not incorporate the amendment to change U.S. Serial No. 09/239,392" to "U.S. Serial No. 09/293,392 on Page 1, line 1 of the above-referenced U.S. Application No. 09/605,599. Copies of the Response, which included a Transmittal of Substitute Specification and Statement that Substitute Specification Contains No New Matter, and the first page of the substitute specification are attached hereto as **Exhibits J and K**, respectively.

10. A second Office Action issued in the above-referenced U.S. Application No. 09/605,599 on March 29, 2002, which, *inter alia*, noted receipt and entry of the substitute specification. A copy of page 2 of this Action with this notation is attached hereto as **Exhibit L**.

11. A Notice of Abandonment was mailed in the above-referenced U.S. Application No. 09/605,599 on November 5, 2002, indicating abandonment due to a failure to respond to the March 29, 2002 Office Action.

The PCT Application No. PCT/US01/20887

12. On June 28, 2001, an International Application claiming Paris Convention priority to the above-referenced U.S. Application No. 09/605,599 was filed and assigned PCT Application No. PCT/US01/20887. A copy of the Request for International Application with the priority claim is attached hereto as **Exhibit M**.

The 10/258,633 U.S. National Phase Application

13. On October 24, 2002, the national phase was entered in the U.S. based on PCT Application No. PCT/US01/20887, which application was assigned U.S. National Phase Application No. 10/258,633. A copy of the returned postal card evidencing this filing is attached hereto as **Exhibit N**.

14. U.S. National Phase Application No. 10/258,633 was filed, which included a Related Application Data statement at page 1, lines 3-11, the pertinent part reading as follows:

“This application is a continuation-in-part application of U.S. Serial No. 09/239,392 filed April 16, 1999 which is a continuation-in-part application of U.S. Serial No. 09/226,580 filed January 7, 1999... .”

A copy of the first page of the application which includes the Related Application Data first paragraph as filed is included for the Examiner's convenience as **Exhibit O**.

15. In U.S. National Phase Application No. 10/258,633, a Petition to Accept an Unintentionally Delayed Claim of Priority under 37 C.F.R. §1.78(a)(3) was filed on May 6, 2009, which included an Amendment to the Specification – Priority Claim and a substitute Application Data Sheet. Copies of this petition and its attachments are attached hereto as **Exhibit P**.

16. A Decision on Petition under 37 C.F.R. §1.78(a)(3) was mailed August 25, 2009 in connection with U.S. National Phase Application No. 10/258,633, which indicated a dismissal of the aforementioned petition for allegedly failing to meet the requirement to supply “the reference required by 35 U.S.C. § 120 and 37 C.F.R. 1.78(a)(2)(i) of the prior-filed application, unless previously submitted.” A copy of this Decision is attached hereto as **Exhibit Q**.

17. A Request for Reconsideration of Petition to Accept an Unintentionally Delayed Claim of Priority under 37 C.F.R. §1.78(a)(3) was filed in U.S. National Phase Application No. 10/258,633 on September 18, 2009, which made further amendments to the Related Application Data paragraph, including, *inter alia*, a correction to the incorrect Application No. 09/239,392 to the correct Application No. 09/293,392. A copy of this Request for Reconsideration is attached hereto as Exhibit R.

18. A Decision on Petition under 37 C.F.R. §1.78(a)(3) was mailed December 8, 2009 in connection with U.S. National Phase Application No. 10/258,633, which indicated a dismissal of the aforementioned Request for Reconsideration for allegedly failing to meet the requirement to supply "the reference required by 35 U.S.C. § 120 and 37 C.F.R. 1.78(a)(2)(i) of the prior-filed application, unless previously submitted." A copy of this Decision is attached hereto as Exhibit S.

POINTS TO BE REVIEWED

It is requested that the 35 U.S.C. § 120 benefit claim in the above-referenced U.S. Application No. 09/605,599 be permitted to be corrected even though the application stands abandoned. It is necessary to correct the benefit claim in U.S. Application No. 09/605,599 in order to have a clear and continuous benefit claim back to the originally filed U.S. Application No. 08/321,051 filed October 5, 1994 in the subsequently filed child Application No. 10/258,633. Once this benefit claim is corrected in the above-referenced application, the conditions under 37 C.F.R. §1.78(a)(3) required in connection with the subsequently filed child Application No. 10/258,633 will be met. It is submitted that this petition is timely since it is being filed within two (2) months of the Decision on Petition under 37 C.F.R. §1.78(a)(3), mailed December 8, 2009, in U.S. National Phase Application No. 10/258,633.

Although the benefit claim in the above-referenced U.S. Application No. 09/605,599 contained a typographical error in the application as filed (see Exhibit A), the correct application number

was set forth in the executed Declaration and Power of Attorney document at the time the application was filed (see Exhibit D).

Further, the benefit claim was corrected in the above-referenced U.S. Application No. 09/605,599 upon entry of the Preliminary Amendment dated November 7, 2000 (see Exhibit F). Specifically, upon entry of the Preliminary Amendment, the Related Application Data paragraph read as follows:

This application is a continuation-in-part application of U.S. Serial No. 09/293,392 filed April 16, 1999 which is a continuation-in-part application of U.S. Serial No. 09/226,580 filed January 7, 1999, which is a continuation-in-part application of U.S. Serial No. 09/833,842 filed April 10, 1997, now U.S. Patent No. 5,968,983 dated October 19, 1999 which is a continuation-in-part application of U.S. Serial No. 08/693,882 filed August 5, 1996, now U.S. Patent No. 5,767,160 dated August 6, 1996, which is a continuation-in-part application of U.S. Serial No. 08/321,051 filed October 5, 1994, now U.S. Patent No. 5,543,430 dated June 16, 1998.

It is true that the substitute specification filed on November 15, 2001 did not include the amendment made in the Preliminary Amendment (see Exhibit J). However, since the substitute specification did not include the updated priority benefit claim as set forth in the Preliminary Amendment, it should not have been entered by the Office (see Exhibit K). It appears that the Preliminary Amendment was not properly entered and/or was not reviewed or considered by the Examiner when the substitute specification was considered for entry.

Subsequently, the above-referenced U.S. Application No. 09/605,599 was abandoned by non-response to the March 29, 2002, Office Action and therefore no response was made of record with regard to the incorrect entry of the substitute specification.

In addition, when the Related Application Data was culled by USPTO personnel from the above-referenced U.S. Application No. 09/605,599 as filed for completion of the official Filing Receipt, there was no indication thereon that the data provided by Applicant in the application was incorrect (see Exhibit E). In the normal course, if inconsistent information is found by USPTO personnel between the data presented by the Applicant and the data in the USPTO data records, a notation on the Filing Receipt of such an inconsistency is noted. Such inconsistency notice was not present on either the first Filing Receipt (see Exhibit E), or the "corrected" Filing Receipt (see Exhibit H) (received after the filing of the Preliminary Amendment to correct the Related Application Data). This error appears to have further perpetuated the problem in correction of the benefit claim.

Most significantly, it is clear from the record that a mere typographical error occurred in the Related Application Data statement in the above-referenced U.S. Application No. 09/605,599 with regard to the application number that is at issue at the time the above-referenced application was filed. The clear error is supported when one reviews the information presented in Exhibit C. In addition, this error was made without deceptive intent and was clearly merely typographical in nature.

ACTION REQUESTED

It is requested that the 35 U.S.C. § 120 benefit claim in the above-referenced U.S. Application No. 09/605,599 be permitted to be corrected even though the application stands abandoned. Specifically, it is requested that the Related Application Data statement starting on Page 1, line 5 be amended and that the bibliographic information in the USPTO records be amended to read follows:

This application is a continuation-in-part application of U.S. Serial No. 09/293,392 filed April 16, 1999 which is a continuation-in-part application of U.S. Serial No. 09/226,580 filed January 7, 1999, which is a continuation-in-part application of U.S. Serial No. 09/833,842 filed April 10, 1997, now U.S. Patent

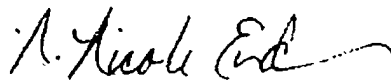
No. 5,968,983 dated October 19, 1999 which is a continuation-in-part application of U.S. Serial No. 08/693,882 filed August 5, 1996, now U.S. Patent No. 5,767,160 dated August 6, 1996, which is a continuation-in-part application of U.S. Serial No. 08/321,051 filed October 5, 1994, now U.S. Patent No. 5,543,430 dated June 16, 1998.

For the Examiner's convenience, attached as Exhibit T is a diagram showing the related application data.

It is submitted that this petition is timely since it is being filed within two (2) months of the Decision on Petition under 37 C.F.R. §1.78(a)(3), mailed December 8, 2009, in child Application No. 10/258,633. The required fee is being paid herewith. The Director is hereby authorized to charge any additional fees in connection with this petition to Deposit Account 50-0436.

Early and favorable action are earnestly solicited.

Respectfully Submitted,



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